

[a]s a general proposition, an applicant has the right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant to eventually have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim...

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to *restrict* an *application* to one of several claimed inventions when those inventions are found to be “independent and distinct.”

It does not, however, provide a basis for an examiner acting under the authority of the Commissioner to *reject* a particular *claim* on the same basis.

*Id.* at 331-332 (emphasis in the original). The same court also held that refusal to act on a claim in restriction practice in fact amounts to a rejection in *In re Haas*, 179 U.S.P.Q. 623, 625 (C.C.P.A. 1973). As the foregoing excerpt from *Weber* explains, § 121 does not provide a basis for rejecting a particular claim. *See Weber* at 332. Accordingly, § 121 does not empower the P.T.O. to refuse to examine a single claim on the merits simply because the P.T.O. asserts that the claim is drawn to independent and distinct inventions. Rather, the “basic right of the applicant to claim his invention as he chooses” under § 112 is “paramount” over the P.T.O.’s right to control “such administrative matters as examiner caseloads and amount of searching done per filing fee.” *See Weber* at 332.

Accordingly, Applicants respectfully request reconsideration of the Restriction Requirement pursuant to 37 C.F.R. § 1.143.

### **CONCLUSION**

Applicants submit that the claims are in condition for allowance. An early indication of the same and passage of Claims 136-159, 161-170, 173-186, 187-190, 193-197, and 202-204 to issuance is therefore kindly solicited.

A Petition for an Extension of Time accompanies this request. Applicants believe no other fee is due in connection with this response. However, the Commissioner is authorized to charge all

required fees, fees under 37 C.F.R. § 1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP U.S. Deposit Account No. 16-1150. (11134-005-999)

Respectfully submitted,

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